



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/092,791	06/05/1998	MATTHIAS EICHSTAEDT	AM9-98-023	6514

22462 7590 02/10/2005

GATES & COOPER LLP
HOWARD HUGHES CENTER
6701 CENTER DRIVE WEST, SUITE 1050
LOS ANGELES, CA 90045

EXAMINER

KANG, PAUL H

ART UNIT	PAPER NUMBER
----------	--------------

2141

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/092,791	EICHSTAEDT ET AL.	
	Examiner	Art Unit	
	Paul H Kang	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,15,27 and 40-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,15,27 and 40-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 2-14, 16-26, and 28-39 have been cancelled. Claims 40-66 are newly added.

Claims 1, 15, 27 and 40-66 are now pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13 and 15-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Klug et al., US Pat. No. 5,996,007.

3. As to claims 1, 15 and 27, Klug discloses a method and apparatus for alleviating problems associated with delays in accessing data on network (See Klug, Summary of the Invention, col. 1, line 62 – col. 3, line 67), comprising the steps of:

a) accessing data on a network from a client computer (Klug teaches loading web pages, see specifically col. 2, line 63 – col. 3, line 16);

b) identifying when a sufficient delay occurs during the accessing step (Klug, col. 2, line 63 – col. 3, line 16; col. 3, lines 40-59 and col. 7, line 34 – col. 8, line 39); and

Art Unit: 2141

c) presenting filler contents on the client computer during the identified sufficient delay, wherein the filler contents are customized to a user's taste (Klug, col. 7, line 34 – col. 8, line 39 and col. 8, lines 40-53).

4. As per claims 40 and 58, Klug teaches a method, apparatus and computer program carrier wherein the identifying step is performed by a server computer connected to the client computer via the network (Klug, col. 5, line 45 – col. 6, line 4).

5. As per claims 41, 49, 50 and 59, Klug teaches a method, apparatus and computer program carrier wherein the sufficient delay is identified by the server computer and then communicated to the client computer to trigger the presenting of the filler contents on the client computer (Klug, col. 2, line 63 - col. 3, line 59).

6. As per claims 42, 51 and 60, Klug teaches a method, apparatus and computer program carrier wherein the filler contents are provided by the server computer (Klug, col. 5, line 45 – col. 6, line 4)..

7. As per claims 52 and 61, Klug teaches a method, apparatus and computer program carrier wherein the filler contents are selected by the server computer (Klug, col. 5, line 45 – col. 6, line 4).

Art Unit: 2141

8. As per claims 43, 53 and 62, Klug teaches a method, apparatus and computer program carrier wherein the filler contents are directly related to the accessed data or the user's transaction or session (Klug, col. 5, line 45 – col. 6, line 4 and col. 7, line 33 – col. 8, line 5).

9. As per claims 44, 54 and 63, Klug teaches a method, apparatus and computer program carrier wherein presenting of the filler contents do not interrupt the accessing of the data (Klug, col. 5, line 45 – col. 6, line 21).

10. As per claims 45, 55 and 64, Klug teaches a method, apparatus and computer program carrier wherein the filler contents are presented while the accessing of the data continues (Klug, col. 5, line 45 – col. 6, line 21).

11. As per claims 46, 56 and 65, Klug teaches a method, apparatus and computer program carrier wherein, if the presenting of the filler contents completes before the accessing of the data completes, new filler contents are presented (Klug, col. 3, lines 40-59; col. 5, line 45 – col. 6, line 53 and col. 8, lines 6-52).

12. As per claims 47, 57 and 66, Klug teaches a method, apparatus and computer program carrier wherein, if the accessing of the data completes before the presenting of the filler contents completes, the presenting of the filler contents is terminated (Klug, col. 2, line 63 - col. 3, line 59; col. 5, line 45 – col. 6, line 21 and col. 8, lines 6-52).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 and 15-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Judson, US Pat. No. 5,572,643, in view of Klug et al., US Pat. No. 5,996,007.

14. As to claims 1, 15 and 27, Judson discloses the invention substantially as claimed. Judson discloses a method and apparatus for alleviating problems associated with delays in accessing data on network (Judson, col. 1, line 13 – col. 2, line 53), comprising the steps of:

a) accessing data on a network from a client computer (a client connected to a server through a network [Judson, client/server network depicted in fig. 1] accesses web pages using web browsers [Judson, fig. 2, element 62]; Judson, col. 1, line 13 – col. 2, line 53);

c) presenting filler contents on the client computer [during the accessing step] (latency-filler contents, customized on user interest, are displayed during web page access; Judson, col. 5, line 50 – col. 6, line 24 and col. 7, lines 2-17).

However, Judson does not specifically disclose step b) identifying when a sufficient delay occurs during the accessing step. In the same field of endeavor, Klug teaches determining the wait time associated with a particular web site access request and presenting wait time messages based on the wait time (Klug, col. 2, line 63 – col. 3, line 16 and col. 7, line 34 – col. 8, line 39).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the step of determining the wait time, as taught by Klug, into the filler data display system of Judson, for the purpose of enhancing acceptability of the system to end-users by increasing customization to user preferences and decreasing intrusion to the Internet session.

15. As per claims 40 and 58, Judson-Klug teaches a method, apparatus and computer program carrier wherein the identifying step is performed by a server computer connected to the client computer via the network (Klug, col. 5, line 45 – col. 6, line 4).

16. As per claims 41, 49, 50 and 59, Judson-Klug teaches a method, apparatus and computer program carrier wherein the sufficient delay is identified by the server computer and then communicated to the client computer to trigger the presenting of the filler contents on the client computer (Klug, col. 2, line 63 - col. 3, line 59).

17. As per claims 42, 51 and 60, Judson-Klug teaches a method, apparatus and computer program carrier wherein the filler contents are provided by the server computer (Klug, col. 5, line 45 – col. 6, line 4)..

18. As per claims 52 and 61, Judson-Klug teaches a method, apparatus and computer program carrier wherein the filler contents are selected by the server computer (Klug, col. 5, line 45 – col. 6, line 4).

19. As per claims 43, 53 and 62, Judson-Klug teaches a method, apparatus and computer program carrier wherein the filler contents are directly related to the accessed data or the user's transaction or session (Klug, col. 5, line 45 – col. 6, line 4 and col. 7, line 33 – col. 8, line 5).

20. As per claims 44, 54 and 63, Judson-Klug teaches a method, apparatus and computer program carrier wherein presenting of the filler contents do not interrupt the accessing of the data (Klug, col. 5, line 45 – col. 6, line 21).

21. As per claims 45, 55 and 64, Judson-Klug teaches a method, apparatus and computer program carrier wherein the filler contents are presented while the accessing of the data continues (Klug, col. 5, line 45 – col. 6, line 21).

22. As per claims 46, 56 and 65, Judson-Klug teaches a method, apparatus and computer program carrier wherein, if the presenting of the filler contents completes before the accessing of the data completes, new filler contents are presented (Klug, col. 3, lines 40-59; col. 5, line 45 – col. 6, line 53 and col. 8, lines 6-52).

23. As per claims 47, 57 and 66, Judson-Klug teaches a method, apparatus and computer program carrier wherein, if the accessing of the data completes before the presenting of the filler contents completes, the presenting of the filler contents is terminated (Klug, col. 2, line 63 - col. 3, line 59; col. 5, line 45 – col. 6, line 21 and col. 8, lines 6-52).

Response to Arguments

Applicant's arguments filed September 16, 2004 have been fully considered but they are not persuasive.

The applicants argued in substance that the prior art of record failed to “teach or suggest the specific combination of limitations including ‘accessing data on a network from a client computer,’ ‘identifying when a sufficient delay occurs during the accessing step,’ and ‘presenting filler contents on the client computer during the identified sufficient delay.’” See Remarks, page 7. Specifically, the applicants argued that “Klug does not identify when a sufficient delay occurs. Instead, Klug always displays a message whenever a site request is made by a user. The [portions of Klug relied upon by the examiner] merely state that the length of the waiting time messages are selected on the basis of the anticipated duration of the waiting time.” Remarks, page 9.

The examiner respectfully disagrees with the applicants’ interpretation of the prior art of record. As noted by the applicants, Klug teaches that the length of the waiting time messages are selected on the basis of the anticipated duration of the waiting time. Stated differently, Klug teaches first determining the duration of a delay, then if the duration is sufficient, displaying a message or messages corresponding to the duration for display to the user during this delay. See Klug, col. 3, lines 52-59.

The applicants argue that the limitation of determining sufficient delay as claimed requires that not all site requests will result in displaying a message, and this limitation distinguishes the invention from the prior art. First, this interpretation of the limitation is not

Art Unit: 2141

essential to the scope of the prior art. The definiteness of the language employed must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Insofar, the claims have been given the broadest reasonable interpretation consistent with the specification and the prior art, since the applicant may then amend his claims, the thought being to reduce the possibility that after a patent is granted the claims may be interpreted as giving broader coverage than is justified.

First, the purpose of identifying a sufficient delay in the invention as suggested by the applicant is for determining whether a message should be displayed at all, and the purpose in Klug is for determining which message to display. However, the interpretation of “sufficient delay” as claimed does not require this distinction. The scope of the limitation “identifying when a sufficient delay occurs” encompasses both determining whether a message should be displayed and which message should be displayed. Accordingly, this distinction made by the applicants is not given patentable weight.

Second, assuming arguendo that the claims require whether a message should be displayed, the Klug reference would nevertheless anticipate the claimed invention. For instance, if the system of Klug contained only one message thirty (30) seconds in duration, and the identified duration is only ten (10) seconds in duration, then by default no message is displayed. Necessarily, the system as taught by Klug inherently determined whether said message should be displayed based on the duration of the message and the delay.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2141

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



PAUL H. KANG
PRIMARY PATENT EXAMINER